

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. APPLN. NO. 10/829,178

**AMENDMENTS TO THE DRAWINGS**

Please insert the enclosed replacement formal drawing sheets 4/5 and 5/5 in which Figs. 4A, 4B, 5A, 5B, 5C and 5D have been individually designated as "Prior Art", and in which the reference characters Ba', Bb' and SP' have been deleted in Fig. 4B.

Also, please insert the enclosed replacement formal drawing sheet 3/5 in which the reference characters GB have been deleted from Fig. 3B.

Attachment: Replacement Sheets 3/5, 4/5 and 5/5

**REMARKS**

Applicant cancels "method" claim 2 without prejudice, and expressly reserves the right further to prosecute, in a Divisional Application, claims directed to the "method" invention.

With respect to page 2, paragraph 3a of the Office Action, Applicant has amended the drawing to delete the drawing reference characters GB (Fig. 3B) and Ba', Bb' and SP' (Fig. 4B). With respect to paragraph 3b, Applicant has labeled Figs. 4B, 5B, 5C and 5D as "PRIOR ART". Thus, Applicant respectfully requests the Examiner to withdraw both objections to the drawings.

Applicant amends the title of the specification to be more clearly indicative of the invention as claimed.

Applicant requests the Examiner to reconsider and withdraw the objection to the disclosure (paragraph 5 on page 3 of the Office Action) in view of the above corrective amendments to the specification.

Applicant has amended the specification and claims to capitalize the trademarks used therein. (Applicant's investigation reveals that: PERMALLOY is a Fe-Ni alloy; SENDUST is an alloy of Fe-Si-Al; and ALPERM is an alloy of 13-17% Al-Fe (balance).)

Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of claims 14-17 under 35 U.S.C. § 112, second paragraph, in view of the above corrective amendments to these claims.

Examiner Renner issues the following five (5) statutory prior art rejections:

(1) Claims 1 and 14 are rejected under 35 U.S.C. § 102(b) as being anticipated by Makimura '164.

(2) Claims 1 and 3-17 are rejected under 35 U.S.C. § 102(b) as being anticipated by Inagoya '955.

(3) Claims 1 and 18 are rejected under 35 U.S.C. § 102(b) as being anticipated by Okada '306.

(4) Claims 1, 5, 8 and 11 are rejected under 35 U.S.C. § 102(b) as being anticipated by Miwa '353.

(5) Claims 18-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable (obvious) over Inagoya '955.

Applicant respectfully **traverses** each of these rejections.

With respect to rejections (1) through (4), a rejection based on anticipation requires that the applied references disclose, either expressly or inherently, each limitation of each of the rejected claims, or in other words, that each of the rejected claims be **readable** on the applied reference.

Applicant respectfully submits that clearly such is **not** the case here.

The Examiner dismisses key limitations in the independent claim 1 as "intended use limitations", whereas these limitations are, in fact, functions of the recited "DC erase head" and "servo write head", respectively.

Applicant has recast claim 1 to recite these heads in the form of **means-plus-function**, thereby making clear that the recited function is a **limitation which must be addressed by the Examiner**. For this recast format of claim 1, Applicant requests the Examiner to consider the similarly drafted claim 7 in Inagoya '955.

Since neither Makimura, Inagoya, Okada nor Miwa teaches or even suggests all of the limitations of Applicant's independent parent claim 1, Applicant respectfully requests the Examiner to reconsider and withdraw all rejections (1) - (4) and to allow claims 1, 3-17 and new claim 21.

More specifically, with respect to the rejections (1) through (4), none of the applied references even recognizes the problem of recording and reading the servo track (see, for example, the  $\Delta D$  displacement illustrated in prior art Fig. 4B, and discussed in Applicant's specification at page 4 and pages 16-17), let alone Applicant's claimed (claim 1) novel and unobvious solution/structure for curing this problem.

Thus, since none of the references applied in the anticipation rejections (1) - (4) teaches, or even suggests, all of the limitations of claims 1, 2-16 and new claim 21, Applicant respectfully requests the Examiner to reconsider and withdraw these rejections and to allow these claims which clearly are **not readable** on these references. (Claim 21 specifies the relative positions of the erase and write heads as described in the specification.)

With respect to rejection (5), since, as explained above, Inagoya does not disclose, or even suggest, all of the limitations of independent parent claim 1, it is clear that Inagoya does **not** disclose or suggest **all of the limitations** of the dependent claims 18-20 (or 21). Therefore, a *prima facie* case of obviousness of the subject matter of claims 18-20 (and 21) has not been established, whereby Applicant respectfully requests the Examiner also to reconsider and withdraw the rejection (5) and to allow claims 18-20.

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In summary, then, and in view of the above amendments and explanations, Applicant respectfully requests the Examiner to reconsider and withdraw all objections, requirements and rejections and to find the application to be in condition for allowance with all of claims 1 and 3-21; however, if for any reason the Examiner feels that the application is not now in condition for allowance, he is respectfully requested to **call the undersigned attorney** to discuss any unresolved issues and to expedite the disposition of the application.

Filed concurrently herewith is a Petition (with fee) for an Extension of Time of One Month. Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this application, and any required fee for such extension is to be charged to Deposit Account No. 19-4880. The Commissioner is also authorized to charge any additional fees under 37 C.F.R. § 1.16 and/or § 1.17 necessary to keep this application pending in the Patent and Trademark Office or credit any overpayment to said Deposit Account No. 19-4880.

Respectfully submitted,

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